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10/585,041

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Ashok Kumar Gupta

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EXAMINER

CUTLIFF, YATE KAI RENE

ART UNIT

PAPER NUMBER

1621

NOTIFICATION DATE

DELIVERY MODE

11/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/585,041 | <b>Applicant(s)</b><br>GUPTA ET AL. |  |
|                              | <b>Examiner</b><br>YATE' K. CUTLIFF  | <b>Art Unit</b><br>1621             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1 – 3 and 6 - 12 are pending.  
Claims 4 and 5 have been canceled  
Claims 1 – 3 and 6 - 12 are rejected.

### ***Response to Amendment***

2. The amendment to claims 1 and 11, submitted July 1, 2009 is acknowledged and entered.

### ***Response to Arguments***

3. Applicant's arguments, see page 5, filed July 1, 2009, with respect to the 35 USC 112 second paragraph rejection of claim 1 have been fully considered and are persuasive in view of the amendment. The 35 USC 112 second paragraph rejection of claim 1 has been withdrawn.
4. Applicant's arguments, see page 5, filed July 1, 2009, with respect to the 35 USC 103(a) rejection of claim 4 have been fully considered and are persuasive in view of the claim cancellation. The 35 USC 103(a) rejection of claim 4 has been withdrawn.
5. Applicant's arguments filed July 1, 2009 with respect to the 35 USC 103(a) rejections of claims 1-3 and 6-12 have been fully considered but they are not persuasive for the reasons set out in the Office Action mailed April 1, 2009, and as set out below.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoo, (US 2005/0080280 corresponds to WO 03//066567) in view of Hayafuji et al. (US 5,972,057); in view of Yean et al. (Applied Organometallic Chemistry, 2000, vol.

Art Unit: 1621

14); and further in view of Caiudelli (US 4,567,037) for the reasons set out in the Office Action mailed April 1, 2009; and as set out below.

10. Applicant respectfully asserts that the process of Yoo does not describe nor suggest simultaneous esterification and directs Examiner to various paragraphs of the Yoo reference. Further, Applicant states that the process of Hayafugi et al. differs from Applicant's claimed process. Also, Applicant asserts that Ciaudelli differs because the process describes an esterification reaction where water is removed. Lastly, Applicant asserts that Yean differs because there is no suggestion in the reference requiring that the starting material in not pure.

11. In response, Examiner notes that Applicant is arguing that each of the references fails to teach Applicant's claimed process. However, it is the modification of the primary reference, Yoo, via what was taught by the secondary references of Hayafuji et al., Yean et al and Caiudelli, to show Applicant's claimed invention. Clearly the combination of these references discloses what was known by one having ordinary skill in the art at the time of Applicant's claimed process. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. (see *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).

12. Further, Applicant respectfully asserts that there in no suggestion or motivation for the combination of references suggested by the Examiner.

13. In response, Applicant is reminded that the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine

Art Unit: 1621

the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. Also, "an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the improvement is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical, we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. (DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1366, 1368; 80 USPQ2d 1641, 1649, 1651 (Fed. Cir. 2006).) In this instance, each of the claimed features of Applicant's process are taught by the combination of the prior art references. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare a biodiesel as suggested by Yoo using the catalyst taught by Yean et al. and Ciaudelli; and then purify the fatty acid alkyl product with absorbent as suggested by Hayafuji et al. to produce a highly purified fatty acid alkyl ester useful for biodiesel fuel.

Therefore, the invention as a whole was *prima facie* obvious because a person of ordinary skill in the art at the time the invention was made, would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YATE' K. CUTLIFF whose telephone number is (571)272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on (571) 272 - 0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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